

RESPONSE under 37 C.F.R. § 1.116
U.S. Appl. No. 09/649,268

REMARKS

Claims 1-20 are pending in the application. In the current Office Action, the Examiner withdraws the case from appeal and finally rejects all claims in view of previously cited prior art. Reconsideration and allowance of all pending claims are respectfully requested in view of the following remarks.

WITHDRAWAL FROM APPEAL.

The Examiner reopens prosecution from appeal alleging the claims are rejected under new grounds of rejection. However, Applicant respectfully notes that no new prior art appears to have been referenced¹ and thus the statement that "Applicant's arguments with respect to claim 1-20... are moot in view of the new grounds of rejection" is not understood.

CLAIM REJECTIONS.

35 U.S.C. § 103(a)

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 5,748,084 to Isikoff in view of the Advanced Configuration and Power Interface (Feb-2-1999) (hereinafter "ACPI") Applicant respectfully traverses this rejection in view of the remarks that follow.

A *prima facie* obviousness is only established when three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success.

¹ While the Examiner now expressly cites the ACPI reference in the rejection, this prior art reference had already been referenced in previous rejections as resembling the status of what was well known in the art.

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Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144) (emphasis added).

In the instant rejection, the Office Action alleges the combination of Isikoff and ACPI discloses all of the limitations of Applicant's independent claims 1, 8 and 18. Applicant respectfully disagrees.

Certain embodiments of Applicant's invention are directed to a portable computing device 10 including a modem 70 that may be used to transmit or receive data while a main processor 50 is deactivated (e.g., in an idle mode or turned off entirely) for conserving power. Specification pg. 6, ll. 6-13. A non-volatile memory 75 may be used to store messages received by modem 70 when processor 50 is inactive.

An exemplary claim for this embodiment is represented by claim 1 which recites:

*A portable computing system comprising:
a modem adapted to receive a communication;
a processor coupled to the modem and adapted to be periodically inactivated to reduce power consumption of the portable computing system; and
a non-volatile memory device coupled to the modem and the processor, wherein the modem is adapted to store at least a portion of the communication in the non-volatile memory for future use by a user, wherein the at least a portion of the communication is stored while the processor is inactive.*

In contrast, Isikoff discloses a security system for locating, communicating with, and managing laptop computers and other portable electronic devices that include a microprocessor and memory. (Col. 1, ll. 3-7). Referring to Isikoff Fig. 4, a host computer 100 may include a beacon 101 and a processor (undesignated). An example implementation of beacon 101 is shown in Fig. 3 which includes a data modem 20 and its own microprocessor 30. Beacon 101 is installed in a host computer 100 such that the data on host computer 100 may be protected from unauthorized access. (Col. 2, ll. 51-67).

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"If the computer [100] is stolen the beacon [101] is advantageously activated to secure its data. This is done in one or more of several ways; it operates to recover or destroy important data, or to disable the computer." (Col. 3, ll. 46-50; emphasis added). Isikoff discloses that the beacon [101] is built-in to computer 100 and has access to various system resources such as hard drive 102 and battery 104. (Col. 4, ll. 14-16). The battery power for the laptop may be routed through the beacon, which may control a switch to cut power to the computer 100 or various subsections thereof. (Col. 4, ll. 16-19).

Isikoff does NOT however, disclose deactivating a main processor to reduce power consumption of the portable device and storing at least a portion of a communication received by the modem in a non-volatile memory while the processor is inactive (deactivated) as recited in Applicant's claims.

In the final Office Action (6-8-05), the Examiner alleges that Isikoff discloses "a memory coupled to the modem when the processor is inactive." (6-8-05 Office Action pg. 3). Applicant respectfully submits the instant claims do not recite "a memory coupled to the modem wherein the processor is inactive," but rather define a non-volatile memory that stores incoming communications for future use by a user while the processor is inactivated for conserving power of the portable computing system). This feature is not disclosed by Isikoff or even the combination of Isikoff and ACPL.

Furthermore, the Office Action correctly notes that Isikoff does not disclose (i) the use of a non-volatile memory and (ii) a processor adapted to be periodically inactivated to reduce power consumption of a portable computing system.

To make up for these deficiencies, the Office Action essentially alleges that since the Isikoff beacon is battery backed, the memory must be a non-volatile memory. Applicant respectfully disagrees and submits that volatile memories are used quite frequently in battery powered devices such as laptop computers. Thus even the combination of Isikoff and ACPI

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cannot render Applicant's claims obvious because, as admitted in the Office Action itself, the cited references fail to disclose or suggest the non-volatile memory claimed by Applicant.

Page 3 of the Office Action further states "[i]t is inherent that a user programs the processes of the modem, as there is no other way for the modem to be functional in this manner." While Applicant is unable to discern what relevance this statement has to the pending claims, Applicant respectfully traverses any assertion of inherency as the Office Action has not demonstrated the modem "necessarily functions" in this manner. For example, it appears a manufacturer could program a modem rather than a user.

On page 4 of the Office Action, the Examiner states "it is not stated why [in Isikoff] the host processor is deactivated....." (Emphasis added). Applicant respectfully disagrees. Isikoff makes it abundantly clear that the computer (or a portion thereof) is deactivated for security reasons (e.g., the computer has been stolen), as opposed to deactivating a processor to reduce power consumption. See, for example, col. 2, ll. 11-14 and ll. 51-56; col. 3, ll. 46-50; col. 4, ll. 15-20; col. 6, ll. 2-4. (See also col. 9, ll. 15-17 in which the power to the main computer is disconnected by a switch in the beacon or the power to the computer is run down.)

The Office Action relies on ACPI to make up for this significant deficiency of Isikoff. While Section 8 of ACPI does disclose various power states for a processor device, nothing in ACPI or Isikoff teaches or suggests allowing incoming communications of a modem to be stored in memory when the processor is inactivated to reduce power consumption. Instead, Isikoff discloses a device security system (see Title) and ACPI discloses various processor designs. Thus even modifying Isikoff's device to have the various power states disclosed in ACPI, there still is lacking any teaching or suggestion of continued modem operation while the main processor is inactive for power conservation reasons.

Since Isikoff and ACPI, taken alone or in combination, fail to teach or suggest the above-mentioned limitations present in Applicant's independent claims, *prima facie* obviousness has

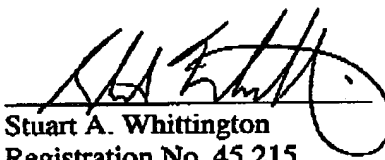
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not been established (*In re Royka*, 490 F.2d 981 (CCPA 1974)) and Applicant respectfully requests the Examiner to reconsider and withdraw this §103 rejection.

CONCLUSION.

In view of the above, reconsideration and allowance of this application is now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee or deficiency thereof, except for the Issue Fee, is to be charged to Deposit Account # 50-0221.

Respectfully submitted,


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Date: September 8, 2005